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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/105,844	06/26/1998	USHA UPADHYAYULA	INTL-0055(P5	6060

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n No.

09/105,844

Applicant(s)

UPADHYAYULA ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2161

--The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

THE REPLY FILED 25 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 25 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 43-60.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



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Continuation of 5. does NOT place the application in condition for allowance because: Applicant arguments:

- 1- Starkweather does not teach "developing a device profile based at least in part on the conditions of the image capture".
- 2- Because there are no teachings about a "device profile" in Starkweather and Inoue, then there no teaching to the limitation of "transferring the graphical object and associated device profile from an imaging device.
- 3- No motivation to combine Inoue with Starkweather.
- 4- None of the three references (Inoue, Starkweather and Ishii) used by the examiner teaches "dynamically generating a device profile".

The Examiner however, respectfully disagrees.

Regarding to Argument No. 1, and in according to Applicant specification (page 6, Lines 4-7 and Page 9, lines 1-15) a "condition of image capture" is the lighting condition or the lighting environment surrounding the image at the time of capturing the image. Keeping this in mind, in addition to the broad claimed limitation, any image device that when it generates a device profile will be effected by the lighting conditions of the surrounding environment, in other words, a light source must be available to create the image profile. This alone would be sufficient enough to reject this limitation as it would be considered inherent. The Examiner however, submitted a second reference for Starkweather in order to better address and to leave no doubt that such a limitation would not render the claim allowable. Starkweather teaches, "developing a device profile based at least in part on the conditions of the image capture" (Figure 2, Element No. 30 and corresponding text; see also Figure 3, Element No. 40 and corresponding text; see also Col 6, Lines 11-20; see also Col 6, Lines 49-52; see also Col 7, Lines 34-42; see also Col 2, Lines 52-56, light source; see also Col 4, Lines 39-51).

Regarding the second argument, the Examiner respectfully disagrees with the Applicant in regard to having no teachings in Starkweather for a "device profile". Starkweather discloses and teaches a "device profile" and the generating of a device profile in many parts of the reference, such as, (Col 2, Lines 16-65; see also Col 3, Lines 63-67; see also Col 4, Line 39 through Col 5, Line 37).

In regard to the third argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the general knowledge available to an ordinary skilled in the art is the ability to modify a plurality of device profiles, such as in Starkweather, (Figure No. 1, Element No. 17 and 19) and in Col 2, Lines 38-42, i.e. the output device is a color printer; see also Col 2, Lines 59-65, i.e. the output device is a display monitor; see also Col 7, Lines 34-42. Inoue reference suggest in a way, the consideration of "image condition" (Abstract, see also Col 5, Lines 18-20, i.e. "color processing parameter 13-15 in the camera, as image sensing conditions") yet the developing of a device profile was not based on the condition of the image capture, but instead was based on forming images (Col 20, Lines 43-45), hence one ordinary skill in the art would be motivated to combine the references in order to increase the flexibility of a device usage by increasing the compatibility of the device with other systems, such as other output devices (Figure No. 1, Element No. 17 and 19).

Regarding argument No. 4, the Examiner would like to bring the Applicants attention to the following citations of Starkweather (Col 8, Lines 29-64, specifically lines 38-39 and lines 56-64).